

REMARKS

In the Office Action the Examiner noted that claims 1-49 are pending in the application, and that claims 28-33, 38-40 and 44-49 have been withdrawn from consideration. The Examiner rejected claims 1-27, 34-37, and 41-43 under 35 U.S.C. § 102(b). The Examiner's rejections are traversed below.

Objection to Drawings

In the Office Action the Examiner objected to the drawings, stating that arrowheads in Figures 1, 3, 8-11, and 19 “should be drawn to show the input or output to each device.” The Examiner requested that Figures 1-18 be labeled as prior art in light of U.S. Patent No. 6,246,975 and Sumner II et al., “Simulating Patients with Parallel Health State Networks,” Proceedings of the American Medical Informatics Association Annual Symposium, p. 438-442, (1998) (hereafter “the AMIA reference”). Additionally, the Examiner stated that “[r]emoving device and connections from figures 10 and 11 will draw figures 10 and 11 to a new matter issues since it is consider a change in the specification and will change the status of figures 10 and 11 of being prior art figures.”

Attached hereto is a revised set of drawings for Figures 1, 3, 10, and 11. The previously deleted elements in Figures 10 and 11 are hereby re-submitted. Formal figures are being prepared to reflect the indicated changes. Applicants respectfully note that there are no missing arrowheads in Figures 8, 9, and 19.

Figures 1-18 are not prior art because the present Application and U.S. Patent No. 6,246,975 were, at the time the inventions were made, commonly owned by The American Board of Family Practice, Inc. Since the figures do not, in themselves, describe the “invention” nor the “subject matter that is sought to be patented,” the fact that the figures are present in an

previously filed and granted patent does not render Figures 1-18 in the present application as anticipated under §102 or obvious under §103. In addition, the AMIA reference as shown below is not available as a prior art reference. Applicant is in the process of obtaining formal drawings to formalize the above corrections.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-27, 34-37, and 41-43 stand rejected under 35 U.S.C. §102(a) as being anticipated by the AMIA reference. Applicants respectfully traverse this rejection.

The AMIA reference is ineligible to be used as §102(a) reference against the present application. 35 U.S.C. § 102(a) provides that:

A person shall be entitled to a patent unless-
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent

The AMIA reference was not “known or used by others...before the invention thereof by the applicant for patent.” As stated in the “Declaration of Walton Sumner II, M.D. and Michael D. Hagen, M.D. Under 37 C.F.R. § 1.132” submitted on May 6, 2003, the co-authors of the AMIA reference, Mirosław Truszczyński, Ph.D. and Victor W. Marek, Ph.D., were not “inventors” of the subject matter described in the AMIA article. The co-authors were named “for their technical assistance to the work,” and “they did not contribute to the conception of the method claimed in the [present] Application and, thus, are not named as co-inventors of the [present] Application.”

The Federal Circuit in In re Katz, stated that “authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. The content and nature of the printed publication, as well as the circumstances surrounding its

publication, not merely its authorship, must be considered.” 687 F.2d 450, 455, 215 USPQ 14, 18 (Fed. Cir. 1982). In Katz, the PTO Board of Appeals sustained a rejection under an article co-authored by the applicant and two others, who were not named as co-inventors in the application. The applicant filed a declaration under Rule 132, stating that he was the “sole inventor of the subject matter which [was] disclosed in said publication” and that the “other authors of the publication...were students working under the direction and supervision of the inventor...and while co-authoring the publication, [were] not co-inventors of the subject matter described therein.” The Board did not find the “declaration, standing alone, sufficient to establish that Katz is the sole inventor and thus remove the [article] as a reference against the presently claimed subject matter.”

The Federal Circuit reversed the Board’s decision, holding that applicant made a “sufficient showing” and that “disclaiming affidavits or declaration by the other authors” were not required to support appellant’s position. 687 F.2d at 455-456, 215 USPQ at 18. “What is required is a reasonable showing supporting the basis for the applicant’s position.” 687 F.2d at 455, 215 USPQ at 18. “In the declaration, appellant provides the explanation that the co-authors of the publication... ‘were students working under the direction and supervision of the inventor.’ This statement is of significance since it provides a clear alternative conclusion to the board’s inference that their names were on the article because they were co-inventors. ...On the record here, the board should not have engaged in further speculation as to whether appellant’s view was shared by his co-authors but rather should have accepted that [the co-authors] were acting in the capacity indicated.” 687 F.2d at 455-456, 215 USPQ at 18.

The AMIA reference is not available as a printed publication until November 1998, and the present application claims priority to April 5, 1999 which is less than 1 year from the publication date of the AMIA reference.

In the Rule 132 declaration filed in the present application, the co-inventor state that the co-authors of the referenced article merely provided technical assistance for their work.

Applicants have made a "reasonable" and "sufficient" showing that they are, in fact, the sole inventors of the subject matter claimed in the present application. This situation is analogous to that of Katz and as such, the AMIA article is not properly cited as prior art. Withdrawal of the rejection of claims 1-27, 34-37, and 41-43 under 35 U.S.C. § 102(b) is respectfully requested.

CONCLUSION

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn. Issuance of a Notice of Allowance is respectfully requested.


AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for this Amendment, or credit any overpayment to deposit account no. 80-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 80-0219.

Respectfully submitted,

HALE AND DORR LLP


Ira H. Donner
Registration No. 35,120



Megan M. Valentine
Registration No. 47,149

1455 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 942-8556
Facsimile: (202) 942-8484
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DC 226222v1